



THE UNITED STATES PATENT AND TRADEMARK OFFICE

AMENDMENT AFTER FINAL

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K. Cyth
8/14/01
N.E.1

APPLICANT: Petkovsek EXAMINER: M. Henderson

SERIAL NO.: 09/322,594 GROUP ART UNIT: 3722

DATE FILED: May 28, 1999 ATTY. DOCKET NO.: USA-P-99-005

INVENTION: "INTEGRAL VARIABLELY PRINTED SERVICE MAILING ASSEMBLY AND A METHOD FOR USING THE SAME"

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S I R:

This Amendment is submitted in response to the Office Action dated June 4, 2001. In the Office Action, the Patent Office rejected Claims 1-15 under 35 U.S.C. §103(a) as being unpatentable over Petkovsek (U.S. Patent No. 5,697,648). Additionally, the Patent Office rejected Claims 16-20 under 35 U.S.C. §103(a) as being unpatentable over Walz (U.S. Patent No. 5,664,725).

With respect to the rejection under 35 U.S.C. §103(a) of Claims 1-15 as being unpatentable over Petkovsek, Applicant respectfully submits that the claims are patentably distinct from Petkovsek and are in allowable form for the reasons that follow.

In paragraph two of the Office Action dated June 4, 2001, the Patent Office stated that Petkovsek discloses a designator section which is contained within the first exterior sides that define the postcard. Applicant respectfully submits that the statement by the Patent Office is in error.

Independent Claim 1 requires a special service mailing assembly having a backing sheet and a first mailing form removably attached to the backing sheet by an adhesive. Further, Claim 1 requires the first mailing form to include a first return postcard integrally formed with a first designator section

indicative of a special service wherein the first designator section is completely contained within first exterior sides that define the first return postcard.

Still further, Claim 1 requires a second mailing form removably attached to the first mailing form wherein the second mailing form is removably attached to the backing sheet by the adhesive and further wherein the second mailing form includes a second return postcard integrally formed with a second designator section indicative of the special service. Finally, Claim 1 requires the second designator section to be completely contained within second exterior sides that define the second return postcard.

Independent Claim 13 requires a method for preparing a mailpiece for delivery of the mailpiece by a special service. The method comprises the steps of providing a backing sheet, a first mailing form and a first return postcard removably attached to the backing sheet wherein the first return postcard is integrally formed with a first special service designation section. Further, Claim 13 requires the first special designation section to be completely within exterior sides that define the first return postcard. An area is provided within the return postcard wherein variable information is printed.

Still further, Claim 13 requires a second mailing form including a second return postcard removably attached to the backing sheet wherein the second return postcard is integrally formed with a second special designation section. Additionally, Claim 13 requires the second special designation section to be completely within exterior sides that define the second return postcard. Finally, information relating to the special service delivery of the mailpiece is printed on the area within the return postcard; the first mailing form is then removed from the backing sheet and attached to the mailpiece to effect delivery of the mailpiece by the special service.

Petkovsek does not teach or suggest a designator section indicative of a special service contained within the exterior

sides of a return postcard. Instead, *Petkovsek* merely discloses a special service indicator section outside the exterior sides of the return postcard. In the Office Action, the Patent Office erroneously refers to the bar code in *Petkovsek* as a designator section indicative of a special service. On the contrary, the bar code section merely aids in the tracking of the article being delivered. The bar code does NOT provide an indication of the special service. Therefore, *Petkovsek* does not disclose a designator section within the exterior sides of the return postcard.

Regarding Claims 1 and 7-9, in paragraph two of the Final Rejection, the Patent Office stated "[I]t would have been obvious to one of ordinary skill in the art at the time the invention was made to have any desirable indicia in the designator section since it would only depend on the intended use of the assembly and the desired information to be displayed. Further, it has been held that when the claimed printed matter is not functionally related to the substrate, it will not distinguish the invention from the prior art in terms of patentability."

However, *Petkovsek* does not provide a designator section contained within the exterior sides of a return postcard as required by Applicant's claims. Applicant submits that it would not have been obvious to one of ordinary skill in the art at the time the invention was made to provide a designator section contained within the exterior sides of a return postcard. Moreover, the designator section is critical to the construction of the assembly and its method of use. More specifically, the designator section contained within the exterior sides of the return postcard allows multiple forms to be placed on a single sheet. This construction satisfies requirements for a designator section associated with the form and simplifies use of the form to complete preparation for delivery of an article by a designated special service.

It is submitted that the question under §103 is whether the totality of the art would collectively suggest the claimed

"invention to one of ordinary skill in this art. *In re Simon*, 461 F. 2d 1387, 174 USPQ 114 (CCPA 1972).

That elements, even distinguishing elements, are disclosed in the art is alone insufficient. It is common to find elements somewhere in the art. Moreover, most, if not all, elements perform their ordained and expected functions. The test is whether the invention as a whole, in light of all the teachings of the references in their entirety, would have been obvious to one of ordinary skill in the art at the time the invention was made. *Connell v. Sears, Roebuck & Co.*, 722 F.2d 1542, 220 USPQ 193 (Fed. Cir. 1983).

With the analysis of the deficiencies of *Petkovsek* in mind, as enumerated above, no reason or suggestion in the evidence of record exists why one of ordinary skill in the art would have been led to modify *Petkovsek* in the manner suggested by the Patent Office in formulating the rejection under 35 U.S.C. §103. Therefore, *prima facie* obviousness has not been established by the Patent Office as required under 35 U.S.C. §103.

In view of the foregoing, the rejection of Claims 1-15 under 35 U.S.C. §103(a) is, therefore, improper and should be withdrawn. Notice to that effect is requested.

With respect to the rejection of Claims 16-20 under 35 U.S.C. §103(a) as being unpatentable over *Walz*, Applicant respectfully submits that the claims of the present invention are patently distinct from *Walz*. More specifically, in paragraph three of the Office Action, the Patent Office stated "[I]t would have been obvious to one of ordinary skill in the art at the time the invention was made to have any desirable indica in the designator section since it would only depend on the intended use of the assembly and the desired information to be displayed. Further, it has been held that when the claimed printed matter is not functionally related to the substrate it will not distinguish the invention from the prior art in terms of patentability. Also, in the present case, there appears to be no new or unobvious structural relationship between the printed

"matter and the substrate."

Further, the Patent Office stated "[I]t would have been obvious to one of ordinary skill in the art at the time the invention was made to include any desirable amount of mailing forms with postcards and anchor portions, since it has been held that mere duplication of the essential working parts of a device involves only routine skill in the art. Furthermore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to omit the adhesive on the underside of the postcard, since it has been held that omission of an element and its function in a combination where the remaining elements perform the same function as before involves only routine skill in the art."

Applicant submits that the Patent Office is in error for the reasons that follow.

Independent Claim 16 requires a mailing assembly for preparing a mailpiece for delivery by a special service. The assembly has a first mailing form having a first return postcard and a first anchor portion removably attached to the first return postcard wherein the first anchor portion has an adhesive on a backside of the first anchor portion. Further, the first return postcard has no adhesive. A first backing strip is received over the adhesive on the backside of the first anchor portion. Claim 16 further requires a second mailing form having a second return postcard and a second anchor portion removably attached to the second return postcard wherein the second anchor portion has the adhesive on a backside of the second anchor portion.

Further, the second return postcard has no adhesive. A second backing strip is received over the adhesive on the backside of the second anchor portion, and a first designator section indicative of a special service is completely contained within exterior sides of the first return postcard wherein the first designator section is integrally formed with the return postcard and a second designator section indicative of a special service completely contained within the exterior sides of the

second return postcard.

Walz does not teach or suggest a first designator section indicative of a special service completely contained within exterior sides of a first return postcard wherein the first designator section is integrally formed with the return postcard and a second designator section indicative of a special service completely contained within the exterior sides of the second return postcard. On the contrary, Walz merely discloses a single multi-part mailing form having two superimposed sheets of material wherein detachable areas of the upper sheet are detached and secured to an item to be mailed, and the sections of the sheets are separable from one another. One of the separable sections includes a return postcard.

Again, the question under §103 is whether the totality of the art would collectively suggest the claimed invention to one of ordinary skill in this art. *In re Simon*, 461 F. 2d 1387, 174 USPQ 114 (CCPA 1972). Because no reason or suggestion in the evidence of record exists why one of ordinary skill in the art would have been led to modify Walz in the manner suggested by the Patent Office in formulating the rejection under 35 U.S.C. §103.

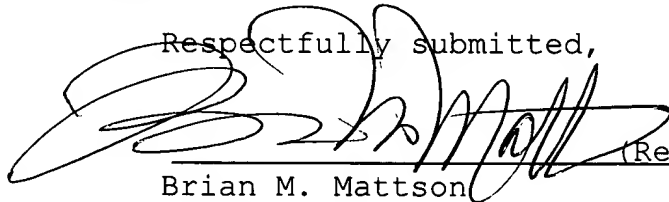
It is insufficient that the art disclosed components of Applicant's claimed invention. A teaching, suggestion, or incentive must exist to make the combination made by Applicant. *Interconnect Planning corp. v. Feil*, 774 F. 2d 1132, 1143, 227 USPQ 543, 551 (Fed. Cir. 1988).

In view of the foregoing, the rejection of Claims 16-20 under 35 U.S.C. §103(a) is, therefore, improper and should be withdrawn. Notice to that effect is requested.

Claims 2-12 depend from Claim 1; Claims 14 and 15 depend from Claim 13; and Claims 17-20 depend from Claim 16. These claims are further believed allowable over the references of record for the same reasons set forth with respect to their parent claims since each sets forth additional steps and structural elements of Applicant's method and system, respectively.

In view of the foregoing remarks and amendments, Applicant respectfully submits that all of the claims in the application are in allowable form and that the application is now in condition for allowance. If, however, any outstanding issues remain, Applicant urges the Patent Office to telephone Applicant's attorney so that the same may be resolved and the application expedited to issue. Applicant requests the Patent Office to indicate all claims as allowable and to pass the application to issue.

Respectfully submitted,



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CERTIFICATE OF MAILING

I hereby certify that this **Amendment After Final** is being deposited with the United States Postal Service as First Class Mail in an envelope addressed to: Asst. Commissioner for Patents, Box AF, Washington, D.C. 20231 on Monday, August 6, 2001.


Brian M. Mattson